A terminal disclaimer is being filed herewith under 37 CFR 1.321 to disclaim the terminal portion of the term of the later of the present application or U.S. Patent No. 6,329,146 B1, both of which are commonly assigned to ISIS Pharmaceuticals, Inc.

I. Rejections under 35 USC § 112(2)

Claims 10, 23 and 78-82 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants traverse the rejection and request reconsideration thereof because the claims set out and circumscribe the subject matter with a reasonable degree of clarity and particularity, and the office action fails to provide any sufficient reasoning to the contrary.

The office action asserts that recitation of "capable of" in claims 10 and 23, and recitation of "bindable" in claim 78 are indefinite, apparently for the reason that it is unclear whether the limitation(s) following these phrases are part of the claimed invention. With no further explanation, the office action seems to imply that using "-able" as a suffix on claim limitations makes such limitations indefinite because it permits, but does not require, inclusion of the recited limitations. Applicants respectfully submit that contrary to what is implied by the office action, using "-able" limitations such as "capable" or "bindable" do not make claims indefinite. In fact, the Federal Circuit interpreted the functional language limitation "means concealable" to limit the scope of a claim to devices that have the *capability* of being concealed.[1] In the cited case, the Federal Circuit determined that the district court had correctly construed the claim as requiring the *capability* of being concealed, although not requiring concealment in actual use. Thus, the use of the "-able" limitation in

[1] R.A.C.C. Indus., Inc. v. Stun Tech, Inc., Civ. App. 98 1186, slip op. at 8-9 (Fed. Cir. Dec. 2, 1998) (unpublished)

"concealable" in this case did not make the claim indefinite. In the present application, accordingly, the recitation of "capable of performing . . ." in claims 10 and 23, and the recitation of "bindable to the . . ." in claim 78 do not make the claims indefinite.

Furthermore, according to MPEP 2173.02, the essential inquiry pertaining to the requirement for definiteness under 35 USC 112, second paragraph, is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. (emphasis in the original) In view of the above, applicants respectfully submit that not only do the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity, but also that the office action fails to provide any sufficient reasoning to the contrary. Accordingly, applicants respectfully request withdrawal of the rejections under 35 USC 112, paragraph 2.

II. Double Patenting Rejections

All claims stand rejected under the judicially created doctrine of obviousness-type double patenting for allegedly being unpatentable over claims 1-35 of U.S. Patent No. 6,329,146 B1 (the '146 patent). Applicants do not acquiesce in the examiner's combination of the '146 patent with other references in application of this doctrine. In any event, applicants file herewith a terminal disclaimer over the '146 patent.

III. Conclusions

Applicants request the Examiner to:

(1) reconsider and withdraw the standing rejections of the claims; and

(2) pass claims 1-26, 36-41, 49-52 and 72-94 to allowance.

If the Examiner is of contrary view, the Examiner is requested to contact the

undersigned attorney at (215) 557-5984.

Respectfully submitted,

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